

S/N 10/799,860

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Vipul Ved Prakash et al.	Examiner:	Jeffrey Swearingen
Serial No.:	10/799,860	Group Art Unit:	2145
Filed:	March 12, 2004	Docket:	2710.007US1
Title:	Method and an apparatus to screen electronic communications		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated below:

In the Final Office Action dated April 15, 2008, the Examiner rejected the claims under the second paragraph of 35 U.S.C. § 112 for indefiniteness and under 35 U.S.C. § 102(a) for anticipation by Aronson et al. (U.S. Patent No. 6,654,787, hereinafter referred to as the Aronson reference). Both rejections are heavily dependent upon how the word ‘length’ is interpreted.

During patent examination, the US PTO gives claims “their broadest reasonable interpretation in light of the specification.” (MPEP 2111.01). More specifically, “this means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” (MPEP 2111.01) Applicants respectfully submit that the Examiner is not using the “plain meaning” of the word “length”, but is instead using a more obscure meaning of the word. Furthermore, the more obscure meaning being used by the Examiner is not reasonable a interpretation since it is inconsistent with the written specification of the application.

Plain Meaning of the Term “Length”

The Merriam-Webster Online Dictionary provides six different definitions for the word “length” as follows:

- Main Entry: length
Pronunciation: \lēnj(k)\th, \lēn(t)\th\
Function: noun
Inflected Form(s): *plural lengths* \lēnj(k)\ths, \lēn(t)\ths, \lēnj(k)\s\
Etymology: Middle English lengthe, from Old English lengthu, from lang long
Date: before 12th century
- 1 a: the longer or longest dimension of an object b: a measured distance or dimension <10 feet in length> — see metric system table, weight table c: the quality or state of being long
 - 2 a: duration or extent in time b: relative duration or stress of a sound
 - 3 a: distance or extent in space b: the length of something taken as a unit of measure <his horse led by a length>
 - 4: the degree to which something (as a course of action or a line of thought) is carried — often used in plural <went to great lengths to learn the truth>
 - 5 a: a long expanse or stretch b: a piece constituting or usable as part of a whole or of a connected series : section <a length of pipe>**
 - 6: the longer or vertical dimension of a piece of clothing —often used in combination <elbow-length sleeves>
- (<http://www.merriam-webster.com/dictionary/length>)

The Applicants submit that the “plain meaning” for the word “length” is captured by the first three definitions presented above. The usage of the word “length” in the claims in light of the specification is most accurately reflected by the first and third definitions listed above. The Examiner contents that that the fifth definition of “length” set forth above is a “plain meaning” of the term. The Applicants respectfully traverse and submit that the meaning of “length” being used by the Examiner is not a “plain meaning” but a more obscure meaning of the term “length”.

Examiner’s Assigned Meaning of the Term “Length” is Inconsistent with the Specification

Even if one were to stipulate that the more obscure meaning of “length” used by the Examiner falls within the “plain meaning” of the term, such a usage of the term is not a “reasonable interpretation in light of the specification” but is instead “inconsistent with the specification”. In support of the Examiner’s view, the Examiner stated that “Applicant did not explicitly define length as a numerical value” in the Advisory Action dated July 2, 2008

Furthermore, the Examiner stated that

It is reasonable to construe generating a signature based on the content of the electronic communication. It is reasonable to call the content a "length" because data is transmitted as a stream, and a section of this data is a portion or "length" of the data. Applicant's claims are broad enough to encompass this reading, and Applicant's specification and responses fail to expressly limit the construction of "length" to a numerical value.

The Applicants respectfully traverse and submit that the Examiner's view as to what a "broadest reasonable interpretation in light of the specification" means is too broad. In the Examiner's view, any meaning of a word that is not explicitly or expressly denied is a "reasonable interpretation". This clearly cannot be true. Virtually all English words have multiple different meanings. To explicitly deny all possible unintended alternative word meanings would require a Herculean effort by patent drafters.

The specific meaning of an English word from the multiple different possible meanings is determined by the context in which the English word is used. Although there may still be some ambiguity since more than one particular meaning may be consistent with the context, the set of possible meanings becomes limited in view of the context. The MPEP uses this system of term interpretation since the MPEP states that "the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification."

(MPEP 2111.01)

In the present case, the Examiner's interpretation of the term "length" is "inconsistent with the specification" since there is no non numerical usage of the word "length" in the written specification. Instead, the term "length" is only used in a numerical form in the written specification. For example, paragraph [0021] explicitly sets forth one particular equation that may be used to calculate the (numerical) "length" value of the electronic communication. Referring to that equation, the Examiner noted that the equation was just "an example of how 'the length *may be* computed'" emphasizing that "may be" does not limit the term "length" to a numerical value." However, the phrase "may be" in this context was only meant to indicate that other numerical equations may be used to compute the "length" value for use in the signature. For example, the original length of the electronic communication (origin_length) may be used as a (numerical) "length" value used to create a signature.

The only use of the term "length" in the specification that comes even remotely

close to appearing to be a non-numerical version would be the usage of the term "length" in the last sentence of paragraph [0020]. That sentence states "Furthermore, processing logic may generate one or more signatures based on the URLs extracted and the length of the electronic communication." But even this usage of the word "length" is clearly numerical since it refers to "the length of the electronic communication". If a sub-section of the electronic communication was intended (the meaning the Examiner is attempting to use), that sentence would have instead referred to "a length of the electronic communication". Such a usage would be consistent with the fifth definition of "length" from the Merriam-Webster's Online Dictionary set forth earlier which used the example of "a length of pipe". But that is not how the word "length" was used in the specification.

The examiner may point to the fact that some of the currently pending claims (such as claim 1) do refer to "a length of the electronic communication". However, the use of the word "a" in the claims is only done because of the strict rules for defining antecedent basis within U.S. patent claims. The usage of the terms in the claims are to be interpreted in light of the specification and all the usages of the term "length" in the specification are clearly for the numerical definition for the term "length". If the Examiner does not object under 35 USC § 112, the Applicants are willing to change the phrase "a length" to "the length" in the claims to clarify the usage of the term.

In view of the above arguments, Applicants submit that it is clear the term "length" is being used with its numerical definition. With this interpretation, Applicants submit that the claims are not indefinite such that the rejection of the claims under the second paragraph of 35 U.S.C. § 112 should be withdrawn. Furthermore, with this interpretation, the Aronson reference does not render the claims unpatentable such that the rejection of the claims under 35 U.S.C. § 103 should also be withdrawn.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4058 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 8/15/2008

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15 day of August 2008.

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